

### **REMARKS**

Claims 1-17 were presented for examination. Independent Claims 9 and 13 are amended. Accordingly, Claims 1-16 remain for further consideration.

#### ***Interview Summary:***

Applicants' undersigned counsel takes this occasion to thank Examiner Noori for the courtesies extended during the personal interview on September 20, 2005.

During the interview, the rejections of Claims 1, 7, 9, 13, and 17 were discussed, as well as the prior art patent upon which those rejections were based – namely U.S. Patent No. 5,966,218, issued to Bokelman et al.

The differences between independent Claims 1, 7, 9, 13, and 17 were explained, as well as differences between each of those independent claims and the Bokelman et al. reference. In addition, proposed amendments to Claims 9 and 13 were discussed. Examiner Noori considered that the proposed amendments to Claims 9 and 13 would present new issues requiring further search, but indicated that proposed amendment to these claims may place them in condition for allowance depending upon a further search, provided that the amendment is made in an RCE application.

As to independent Claims 1, 7, and 17, Applicants' counsel pointed out that these claims involve application of a code to the paper that correlates to data stored in a database for that specific location – in contradistinction to merely marking a defect location on a paper web. Further, counsel noted other differences between the claims and the Bokelman et al. patent, such as use of tipping paper, measurement of a specific parameter – namely permeability, and apparatus to

collect and evaluate a finished cigarette having a particular code. Additional aspects of the interview discussion are further explained in the discussion below.

***The Anticipation Rejection:***

Claims 1-10 and 13-17 presently stand rejected as being anticipated by the Bokelman et al. patent (U.S. Patent No. 5,966,218) within the meaning of 35 U.S.C. § 102(b).

***Response:***

Applicants traverse this rejection as to independent Claims 1 and 7.

The present invention involves a method and apparatus for measuring a characteristic of a cigarette tipping paper at one or more specific locations along a continuous web of the cigarette tipping paper. The measured characteristic is stored in a database file. In addition, a sample code that includes the stored data is printed on the cigarette tipping paper at the specific location where the measurement was performed.

The rejected independent claims, namely Claims 1 and 7 relate to methods applied to cigarette tipping paper – a specialty paper. The methods of these claims measure a characteristic (Claim 1) and specifically permeability (Claim 7) at specific locations along the paper. The methods also provide for applying a code at the specific location of the measurement, where that code includes information about the measurement.

The language used in Claims 1 and 7 is as follows:

- **Claim 1:** “applying a sample code including said stored data associated with a specific location on said cigarette tipping paper at said specific location on said paper”.

- **Claim 7:** “applying a sample code including said stored data associated with a specific location on said tipping paper at each of said one or more specific locations along said paper”.

Independent Claim 9 and 13 relate to methods applied to a more general web of material. The methods of these claims measure a characteristic (Claims 9 and 13) at specific locations along the web. The methods also provide for applying a code at the specific location of the measurement, where that code is selected from the group consisting of letters, numbers, spaced bars and other identifying indicia and includes information about the measurement.

The language used in Claims 9 and 13 to explain these features is as follows:

- **Claim 9:** “printing a sample code having information corresponding to said measured characteristic at the location where said measurement took place”.
- **Claim 13:** “a printing device that is adapted to print a sample code including information corresponding to a measured characteristic of a location on said web, said printing device being positioned to print said sample code on said web at said location on said web”.

The Bokelman et al. patent stands in sharp contrast to the feature described above and recited in the independent claims of this application. More particularly, the Bokelman et al. patent concerns banded paper – which is different in kind from cigarette tipping paper. In addition, the Bokelman et al. patent uses a photoelectric sensor 14 to continuously project a beam of infrared radiation onto the paper. That beam of infrared radiation is reflected by the paper and the reflected beam is detected and used to quantify paper characteristics such as band spacing. (See., Col. 4, lines 36-46). The inspection roller 29, where the paper characteristics are evaluated, includes grooves spaced along its periphery. A camera senses the rate at which these grooves move to provide a time base to synchronize system

activities. (See, Col. 7, lines 35-55). Thus, the speed of the paper can be calculated so that an ink jet printer 20 may mark the location of irregular bands on the passing paper, which bands had been detected upstream. (See, Col. 7, lines 52-55). Information from the relected beam passes through an Ethernet interface to a workstation 330. That workstation includes a separate printer 338 and other peripherals. (See, Col. 9, lines 18-24).

In short, the Bokelman et al. patent does not apply a sample code containing stored data for that location, or including data for that location. Rather, the Bokelman et al. patent identifies the spatial location of an aberration without containing any information about the aberration. By contrast, the information in the sample code of the present invention indicates what the measured value is at that particular location. In addition, the code may include letters, numbers, bar codes, or other identifying indicia, as well as information related to the measured value.

The importance of the distinction becomes even more apparent when the present invention is viewed in context. The present invention provides a mechanism whereby cigarettes having the printed sample code information can be taken from the production line and then tested – the sample code providing information about measured criteria during the manufacturing process. The Bokelman et al. patent, on the other hand, merely applies a “mark” at the site of an aberration – any more substantive information is passed through the Ethernet connection to a workstation that may include its own printer, but that printer does not act on the banded paper being inspected.

Since each of independent Claims 1, 7, 9, and 13 include this feature, Applicants respectfully submit that none of those independent claims is anticipated within the meaning of 35 U.S.C. § 102(b).

Furthermore, Applicants respectfully submit that none of those independent claims would be obvious to one of ordinary skill in the art at the time of the invention considering the Bokelman et al. patent. More particularly, the Bokelman et al. patent provides a paper inspection system that only marks banded paper for the tobacco rod which is out of specification – it does not act on tipping paper and provides no information for use in subsequent testing of cigarettes that are otherwise within manufacturing parameters and tolerances. In contradistinction, the present invention applies a sample code to cigarette tipping paper that is otherwise perfectly within manufacturing parameters and tolerances so that subsequent testing of that cigarette can be accomplished with knowledge of the particular values for that parameter at the time of manufacture.

Accordingly, Applicants submit that the independent claims would not be obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103 in view of the Bokelman et al. patent.

Claims 2-6, 8, 10-12, and 14-16 depend directly or ultimately from one of those independent claims and are, therefore, allowable therewith. Moreover, each of these dependent claims adds one or more additional features to the corresponding independent claim, thus providing a further, independent basis for allowability.

***The Obviousness Rejection:***

Claims 11-12 presently stand rejected as being obvious to one of ordinary skill in the art at the time the invention was made within the meaning of 35 U.S.C. § 103 in view of the Bokelman et al. patent.

***Response:***

Applicants also traverse this rejection. As noted above, these claims are allowable at least for the reason that the independent claim from which they depend is allowable. Accordingly, it is unnecessary to further discuss the specific rejection.

***Conclusion:***

Based on the foregoing, Applicants respectfully submit that all pending claims are now in condition for allowance. Accordingly, Applicants request that a formal notice of allowance be issued.

Respectfully submitted,

**BUCHANAN INGERSOLL PC INCLUDING THE  
ATTORNEYS OF BURNS, DOANE, SWECKER &  
MATHIS**

Date: October 13, 2005

By: 

Regis E. Slutter

Registration No. 26,999

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620